

CERTIFICATE OF MAILING (37 C.F.R. 1.8(a))

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Date:

9/3/04


Rhea C. NersejianIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventor(s): Gelfand et al.
Serial No.: 10/052,417
Filed: 01/17/2002
Title: THERMOSTABLE DNA POLYMERASES
INCORPORATING NUCLEOSIDE
TRIPHOSPHATES LABELED WITH
FLUORESCCEIN FAMILY DYES

PATENT APPLICATION

Art Unit: 1634
Examiner: Sitton, Jehanne Souaya
Confirmation No. 4095

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(c)

Mail Stop Non Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Roche Molecular Systems, Inc. (RMS) having an office at 1145 Atlantic Avenue, Alameda, CA 94501, is the assignee of the entire right, title and interest in, and to the invention described and claimed in the captioned application for Letters Patent of the United States, and in and to said application, and in and to any and all Letters Patent of the United States which may issue from said application.

The present application, U.S. Serial No. 10/052,417, filed January 17, 2002, is a continuation application of U.S. Serial No 09/146,631, filed September 3, 1998, which issued as U.S. Patent No. 6,346,379, which claims the benefit of provisional application 60/058,525 filed September 11, 1997.

The undersigned hereby certifies that the evidentiary documents have been reviewed, and, to the best of undersigned's knowledge and belief, title to the captioned application is in RMS.

RMS hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the captioned application which would extend beyond the expiration date of U.S. Patent No. 6,346,379.

RMS further agrees that any patent so granted on the captioned application, together with any right to recover for its violation, shall be enforceable only for and during such period that the legal title to any patent granted on the captioned application shall be the same as the legal title to U.S. Patent No. 6,346,379. This agreement is to run with any patent granted on the captioned application and is to be binding upon the grantee, its successors or assigns.

RMS does not disclaim the terminal part of the term of any patent granted on the captioned application prior to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No 6,346,379, as presently shortened by any terminal disclaimer, in the event that said patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

RMS makes the above disclaimer without prejudice to its rights to extend, under 35 U.S.C. 154-156, the term of any U.S. patent granted on the captioned application beyond the term provided by this Terminal Disclaimer.

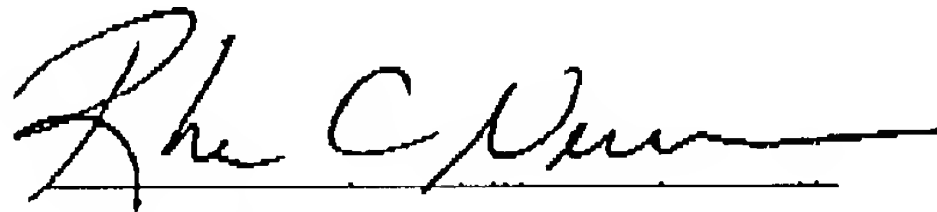
The undersigned has authority to sign since she is an agent of record.

The Commissioner is hereby authorized to charge the required fee of one hundred and ten dollars (\$110.00) as well as any additional fees which may be required, or credit any over payment, to Deposit Account No. 50-0812.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Please address all correspondence regarding this matter to Customer No. 22829.

Respectfully submitted,



Rhea C. Nersesian

Registration No. 55,488

Date: September 3, 2004

Roche Molecular Systems, Inc
1145 Atlantic Avenue
Alameda, CA 94501
Tele: (510) 814-2800
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GEORGE W. JOHNSTON
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 12/18/1997

REEL/FRAME: 3901/0513
NUMBER OF PAGES: 9

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

GELFAND, DAVID H. ✓

DOC DATE: 09/11/1997 ✓

ASSIGNOR:

REICHERT, FRED L. ✓

DOC DATE: 09/11/1997 ✓

ASSIGNOR:

MYERS, THOMAS W. ✓

DOC DATE: 10/09/1997 ✓

ASSIGNOR:

KALMAN, LISA V. ✓

DOC DATE: 09/11/1997 ✓

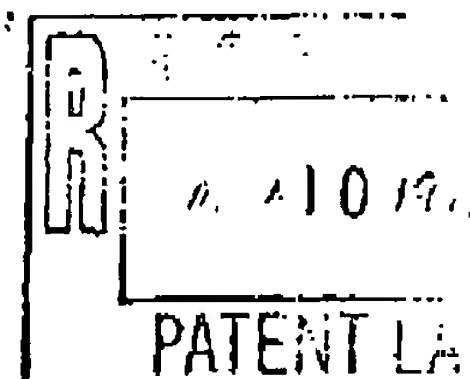
ASSIGNOR:

SIGUA, CHRISTOPHER L. ✓

DOC DATE: 09/11/1997 ✓

ASSIGNEE:

ROCHE MOLECULAR SYSTEMS, INC. ✓
1080 U.S. HIGHWAY 202
BRANCBURG, NEW JERSEY 08876



SEP. 3. 2004 11:24AM

RMS Patent Department

NO. 419

P. 12

8901/0619 PAGE 2

SERIAL NUMBER: 60058525 /
PATENT NUMBER:

FILING DATE: 09/11/1997 -
ISSUE DATE:

MAYA BENNETT, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

JOINT INVENTION

Case Docket No. 1044P

ASSIGNMENT

WHEREAS, WE, David H. Gelfand, Lisa V. Kalman, Fred L. Reichert, Thomas W. Myers and Christopher L. Sigua (Assignors) have invented certain new and useful improvements which are described and claimed in application for United States Patent and identified as Case Docket No. 1044P, entitled:

**THERMOSTABLE DNA POLYMERASES INCORPORATING NUCLEOSIDE
TRIPHOSPHATES LABELED WITH FLUORESC EIN FAMILY DYES**

WHEREAS, ROCHE MOLECULAR SYSTEMS, INC., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at Branchburg, New Jersey, is desirous of acquiring the entire interest in and to said invention, said application and the Patent to be obtained therefor;

NOW, THEREFORE, for and in consideration of One Dollar (\$1.00) and other good and valuable consideration to us in hand paid, the receipt and sufficiency whereof are hereby acknowledged, we have sold, assigned, and set over, and by these presents do hereby sell, assign, and set over unto the said ROCHE MOLECULAR SYSTEMS, INC. (Assignee), and said Assignee's legal representatives, successors, the entire right, title and interest, for the whole world, in and to said invention and said application, as well as any subsequent application which claims priority based upon the filing date of said application identified as Case Docket No. 1044P and the patents, both domestic and foreign, that may or shall result therefrom including the right to claim in respect of any subsequent United States and foreign patent applications and patents, the priority date of said application under any United States statute and international convention or treaty; and we do hereby authorize and request the issuance of said patents, domestic and foreign, conformably to the terms of this Agreement.

UPON SAID CONSIDERATION, we do hereby covenant and agree with the said Assignee that we will not execute any writing or do any act whatsoever conflicting with these presents, and that we will at any time upon request, without further or additional consideration, but at the expense of the said Assignee, execute such additional assignments and other writings and do such additional acts as said Assignee may deem necessary or desirable to perfect the Assignee's enjoyment of this grant, and render all necessary assistance in making application for and obtaining provisional, original, continuation, continuation-in-part, divisional, reissued, re-examined or extended Patent of the United States or of any and all foreign countries on said invention, and in enforcing any rights or choses in action accruing as a result of such applications or patents, including but not limited to, giving testimony in any proceedings or transactions involving such applications or patents, and executing preliminary statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind and inure to the benefit of the assigns and legal representatives of all parties hereto.

IN WITNESS WHEREOF, we have hereunto set our hands and affixed our seals this //day
of Sept, 1997.

Alameda, California, U.S.A.


David H. Gelfand


Fred L. Reichert


Lisa V. Kalman


Christopher L. Sigua


Thomas W. Myers October 9, 1997

ACKNOWLEDGMENT

United States of America)

State of California)

County of Alameda)

On , before me personally appeared

to me known to be the persons described in the foregoing Assignment, who acknowledged that they
executed the foregoing Assignment of their own free will for the purposes therein set forth.

33216

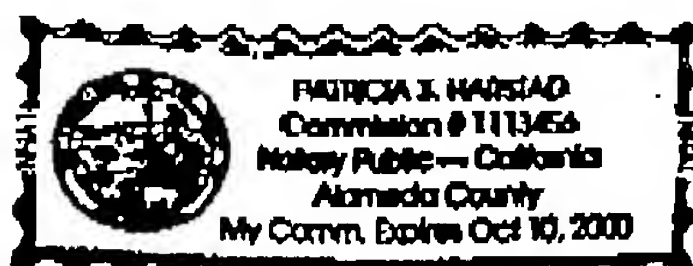
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State of CaliforniaCounty of AlamedaOn Sept 11, 1997 before me, Patricia S. Harstad - Notary Publicpersonally appeared David H. Gelfand

Name and Title of Officer (e.g., "Jane Doe, Notary Public")

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☐ personally known to me - OR - ☒ proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.



WITNESS my hand and official seal.

Patricia S. Harstad
Signature of Notary Public

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Title or Type of Document: AssignmentDocument Date: 9-11-97 Number of Pages: 2Signer(s) Other Than Named Above: Thomas W. Myers, Lisa V. Kalman, Thomas W. Myers, Christopher L. Sigua

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State of California
 County of Alameda

On 10-9-97 before me, Donna Donohue, Notary
DATE NAME, TITLE OF OFFICER - E.G., "JANE DOE, NOTARY PUBLIC"
 personally appeared Thomas W. Myers
NAME(S) OF SIGNER(S)

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WITNESS my hand and official seal.

Donna Donohue
SIGNATURE OF NOTARY

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☐ GENERAL
☐ ATTORNEY-IN-FACT
☐ TRUSTEE(S)
☐ GUARDIAN/CONSERVATOR
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SIGNER IS REPRESENTING:
NAME OF PERSON(S) OR ENTITY(ES)

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DESCRIPTION OF ATTACHED DOCUMENT

Assignment
TITLE OR TYPE OF DOCUMENT

2 + acknowledgments
NUMBER OF PAGES

Sept. 11, 1997
DATE OF DOCUMENT

David Gelman Fred Rochet
Lisa Kalman Christopher Myers
SIGNER(S) OTHER THAN NAMED ABOVE

ALL-PURPOSE ACKNOWLEDGMENTState of CaliforniaCounty of San FranciscoOn September 11, 1997 before me, Gail J. Strack, Notary Public

DATE

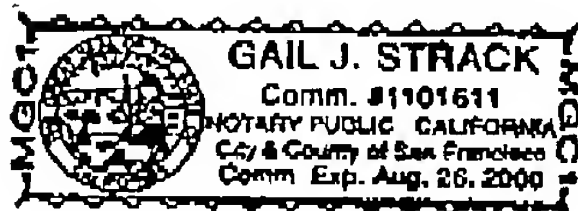
NAME, TITLE OF OFFICER - E.G., "JANE DOE, NOTARY PUBLIC"

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Gail J. Strack
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On

Sept 11, 1997

before me,

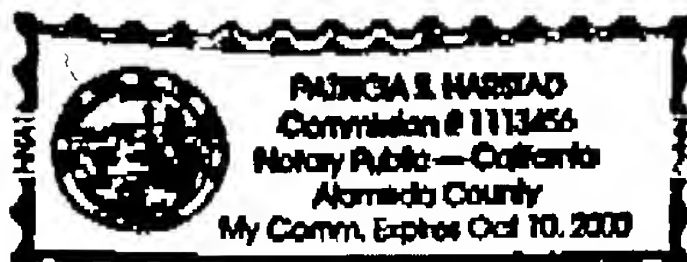
Patricia S. Harstad - Notary Public

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Christopher L. Siqua

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Signature of Notary Public

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Number of Pages:

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Signer(s) Other Than Named Above

Lisa J. Kalman Thomas Meyer
David H. Helfand, Fred H. Reed

Capacity(ies) Claimed by Signer(s)

Signer's Name:

- ☐ Individual
☐ Corporate Officer
Title(s): _____
☐ Partner — ☐ Limited ☐ General
☐ Attorney-in-Fact
☐ Trustee
☐ Guardian or Conservator
☐ Other: _____

Signer Is Representing:

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☐ Corporate Officer
Title(s): _____
☐ Partner — ☐ Limited ☐ General
☐ Attorney-in-Fact
☐ Trustee
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Signer Is Representing:

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CALIFORNIA ALL-PURPOSE ACKNOWLEDGMENT

State of

California

County of

Alameda

On

Sept 11, 1997

Date

before me,

Patricia S. Harstad Notary Public

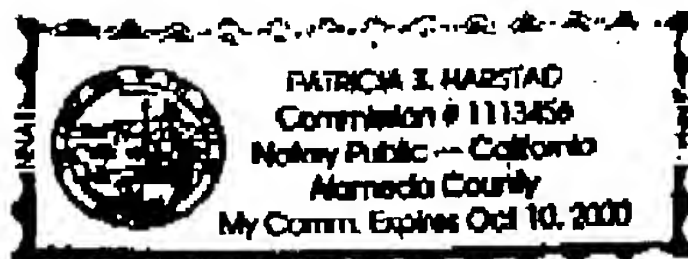
Name and Title of Officer (e.g., "Jane Doe, Notary Public")

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Fred L. Reichert

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Patricia S. Harstad

Signature of Notary Public

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David H. Gelfand, Thomas W. MyersLisa V. Ralston

Capacity(ies) Claimed by Signer(s)

Christopher L. Sigua

Signer's Name:

☐ Individual☐ Corporate Officer

Title(s):

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